REMARKS

This communication responds to the Final Office Action dated October 31, 2008. No claims are amended, no claims are canceled, and no claims are added. As a result, claims 149-183 are now pending in this Application.

§*103 Rejection of the Claims*

Claims 149-183 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Rangan et al. (U.S. Patent No. 6,006,265; hereinafter "Rangan") in view of Kingdon et al. (U.S. Patent No. 5,784,560; hereinafter "Kingdon"). However, since a *prima facie* case of obviousness has not been properly established by the Office, the rejection of these claims is respectfully traversed.

As noted in a previous response, the Office asserts that it would be obvious to combine Rangan and Kingdon "because Kingdon provides a specific implementation for the broad concept touched (in the form of neighborhoods) in Rangan. Combining the teachings of inheritance taught by Kingdon with the neighborhood example of Rangan would produce a predictable result." *Id.* However, as noted in the prior response, the predictable result in this case is an inoperative system.

In the most recent Office Action, the Office states that the "... applicant has not even made an attempt to explain how this concept [taught by Kingdon and] shown in the rejection is not inheritance." Office Action, mailing date 20081028, pg. 2. The Applicants respectfully submit that there is no need to do so.

The initial burden is on the Office to establish a proper *prima facie* case of obviousness. To accomplish this task, the Office must demonstrate: (a) that every feature of the claimed embodiment is present in the proposed combination, and (b) that there is proper motivation to make such a combination. It is this second factor that is lacking in the case set forth by the Office.

When combining the features of two references makes them inoperative, or the references teach away from such a combination, then there is no proper motivation to combine, and it is irrelevant as to whether the references teach all of the claimed features. That is, even when

every claimed element is present in the proposed combination, there are situations when the combination can not be properly made. This is precisely what occurs with the combination of Rangan and Kingdon proposed by the Office.

As noted in the prior response, "... the test for obviousness under §103 must take into consideration the invention as a whole; that is, one must consider the particular problem solved by the combination of elements that define the invention. *See* Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir.1985). The Examiner must, as one of the inquiries pertinent to any obviousness inquiry under 35 U.S.C. §103, recognize and consider not only the similarities but also the critical differences between the claimed invention and the prior art. *See* In re Bond, 910 F.2d 831, 834, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990), reh'g denied, 1990 U.S. App. LEXIS 19971 (Fed. Cir.1990). **The fact that a reference teaches away from a claimed invention is highly probative that the reference would not have rendered the claimed invention obvious to one of ordinary skill in the art.** Stranco Inc. v. Atlantes Chemical Systems, Inc., 15 USPQ2d 1704, 1713 (Tex. 1990). When the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be nonobvious. *Id.* p. 4 citing United States v. Adams, 383 U.S. 39, 51-51 (1966). Additionally, critical differences in the prior art must be recognized (when attempting to combine references). In re Bond, 910 F.2d 831, 834, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990), reh'g denied, 1990 U.S. App. LEXIS 19971 (Fed. Cir.1990)." (emphasis added)

Rangan teaches the use of hyperlinks that are interpreted based on previously-expressed user preferences. *See* Rangan, Col. 9, lines 5-10. Examples include advertising spots chosen to reflect facts that are known about the subscriber/user/viewer, including their expressed proclivities. *See* Rangan, Col. 11, lines 4-19. Thus, Rangan teaches a system that relies on the availability of dynamically changing user preference information, as expressed by the user. *See* Rangan, Col. 9, lines 5-13.

Kingdon, on the other hand, teaches that security problems arise when attributes associated with an object can be changed by non-trusted parties. *See* Kingdon, Col. 3, lines 23-40. For example, Kingdon presents the situation where attributes for a user and a printer (as objects) are not in synchronization with each other to show that access attempts by a user with respect to a the printer, where the rights to such access have not been previously established, are

deemed to be illicit attempts to modify the associated object attributes. *See Id.* at Col. 7, line 48 – Col. 8, line 27. A similar example is specifically used to show that "... someone could, without Company B's consent, tamper with the attributes 37b of the object Boyd 31b and add Printer C C33b as an attribute. As a result, Boyd 31 could access Printer C33 even though Company B did not authorize such access." *Id.* at Col. 4, lines 14-21. Indeed, the only mechanism described by Kingdon for establishing attribute values is that of the system administrator. *See Id.* at Col. 8, lines 42-53. That is, only the system administrator, acting on an *a priori* basis, can set the values of attributes. *See Id.* Ad-hoc user manipulation of object attributes is not permitted.

Thus, if the strictly regulated use of inheritance, as taught by Kingdon, is added to the dependence on dynamic change taught by Rangan, an inoperative system results. This is because attempts to dynamically incorporate changes to the user profile are illicit, according to Kingdon, and will be denied. *See Id.* at Col. 8, lines 19-21. If such modifications are prevented, the system of Rangan ceases to provide different interpretations for a hyperlink based on "the previously expressed preferences of the SUV [subscribers/users/viewers]". *See* Rangan, Abstract and Col. 9, lines 4-13.

In summary, Rangan teaches away from using a system that prevents user activity from modifying preferences on a dynamic basis (e.g., Kingdon). Kingdon teaches away from using a system that allows dynamic user activity to modify the user profile (e.g., Rangan). Thus, one of ordinary skill would not find it obvious to combine these references, as suggested by the Office, because an inoperative system would result. Therefore, reconsideration and withdrawal of the rejection under 35 USC § 103 in view of Rangan and Kingdon is respectfully requested.

CONCLUSION

It is respectfully submitted that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone the undersigned at (408) 278-4041 to facilitate prosecution of this Application. If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on December 17, 2008.

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